LAW OFFICES

PARKHURST & WENDEL, L.L.P.

SUITE 210
1421 PRINCE STREET
ALEXANDRIA, VIRGINIA 22314-2805
TELEPHONE 703 - 739-0220
FACSIMILE 703 - 739-0229
E-Mail parkhurst@worldnet.att.net

To: Examiner Anne Marie Grunberg — **Date:** 10/29/03
Group Art Unit 1661
Company: U.S. PTO — **Fax No.:** 872-9307

From: Charles A. Wendel

Re: U.S. Patent Appln. Serial No. 09/923,534
Mr. Robert Noodelijk - Our Ref.: CHRE:118

__7___ pages including this cover sheet were transmitted. If you do not receive all pages, please let us know by return facsimile.

Dear Examiner Grunberg:

On October 28, 2003 we filed a Request for Reconsideration in the USPTO Mail Room.

Transmitted herewith are courtesy copies thereof and of our firm's return postcard receipt bearing the USPTO Mail Room date stamp confirming that filing.

This copy is presented for your convenience to expedite your consideration of this case. We await receipt of a Notice of Allowability or Advisory Action.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.

CHRE:111

Atty. Docket No.

REQUEST FOR RECONSIDERATION

Description:

Inventor(s): Mr. Robert Noodelijk

Title (new cases): CHRYSANTHEMUM PLANT NAMED 'CREAM ELITE REAGAN'

Attorney: CAW/ch Serial No.: 09/902,750

Paper(s) Filed: November 26, 2003

Date(s) Satisfied: November 26, 2003 NOA still due

N.D.D.: ~~e/u: 11/19 Call Exr~~

PATENT
REPLY AFTER FINAL REJECTION
EXPEDITED PROCEDURE EXAMINING GROUP 1600

MAIL STOP BOX AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Robert Noodelijk **Group Art Unit: 1661**

Serial No.: 09/923,534 **Examiner: Anne Marie Grünberg**

Filed: August 8, 2001

For: CHRYSANTHEMUM PLANT NAMED 'ETNA'

REQUEST FOR RECONSIDERATION

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant requests reconsideration of the Final Rejection mailed August 25, 2003 in view of the following remarks.

The continued rejection of claim 1 under 35 USC 102 as allegedly anticipated by PBR application No. NL PBR CHR3164 in view of the admission that 'ETNA' was first offered for sale abroad in D cember 1999 is respectfully traversed.

Applicant relies upon the arguments presented in the Amendment Under 37 CFR 1.111 filed June 3, 2003 and the following comments and arguments.

Applicant informs the Examiner that the usual grace period in UPOV countries, with the exception of the United States, is four years rather than one year. There is a sound reason for a grace period of such length.

The trade of ornamentals, e.g., chrysanthemums, has become an international activity, part of which includes worldwide trials of n w varieties that were usually bred under specific conditions in one region. Several trials in different seasons are needed to determine whether a new variety is suitable for production in a foreign region and whether the new variety fulfills consumer expectation in, for example, the United States. Due to the considerable costs to obtain U.S. plant patents, foreign breeders usually apply for patents in those instances where both criteria discussed above are positive. However, all the work required sometimes cannot be done within a year after the first sale in the original region. A grace period of four years is much more

realistic and is also the period commonly accepted for the application of Plant Breeders Rights in other UPOV countries.

While applicant realizes that plant protection in the United States is different from the plant protection afforded in other UPOV countries in that the United States uses a legal (pat nt) system rather than a Plant Breeders Right approach, one should take into consideration the common purpose of both systems, namely the protection of the right of the breeder of his or her product. For the international community of breeders, it would be useful if the grace period in the United States comported with that of other UPOV countries.

Further, applicant responds to the Response to Arguments appearing at pages 2 to 5 of the Final Rejection thusly.

The published PBR application, while a printed publication, does not constitute prior art under 35 USC 102 because the publication by the USPTO's own admission is not enabling. If the publication is not enabling, it does not qualify as prior art under 35 USC 102. The reference alone cannot be a proper basis for rejection here.

Sales abroad also are not prior art within the definition of 35 USC 102 (as they are not patent-defeating acts) and the combination of two non-prior art events, regardless of the degree of sophistry involved, does not make a proper rejection under 35 USC 102.

Applicant also respectfully submits that the holding in In re LeGrice supports patentability here and the PBR document is not prior art for the reasons given above.

Applicant also respectfully points out that the panel in Ex parte Thomson itself distinguished the facts before it from that of In re LeGrice and neither decision provides proper support for the USPTO position here.

Serial No. 09/923,534

Reconsideration of the rejection is earnestly solicited.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.

October 28, 2003
Date

Charles A. Wendel
Registration No. 24,453

CAW/ch

Attorney Docket No.: CHRE:118

PARKHURST & WENDEL, L.L.P.
1421 Prince Street, Suite 210
Alexandria, Virginia 22314-2805
Telephone: (703) 739-0220